

REMARKS

Claims 16 and 18 are pending in this case. Applicants hereby cancel Claim 16 and amend Claim 18 in order to remove any possible ambiguity concerning the claimed method.

Applicants respectfully reiterate the arguments presented in the reply mailed July 21, 2003. Applicants assert that prior to the instant invention, one skilled in this art had no knowledge of the non-climacteric nature of blackcurrant. Although Houck teaches a method for obtaining tissue-specific promoters, and although Graham teaches transgenic blackcurrants, neither reference teaches or suggests that blackcurrant is a non-climacteric fruit. Accordingly there is simply no motivation to combine the teachings of Houck and Graham to achieve the objective set forth in the preamble of Claim 18; i.e., to control fruit-specific gene expression in a non-climacteric plant.

The examiner's general assertion that "[t]he references provide each element of the claim and a motivation to combine the references, that is in order to isolate fruit specific promoters from a type of fruit that was a known target for plant transformation" is inaccurate and ignores a critical limitation in Claim 18. The references fail to provide the critical element and limitation in the pending claim: that the plant in which fruit-specific gene expression is being controlled must be non-climacteric. One skilled in this art had no prior knowledge that fruit-specific promoters from blackcurrant could control gene expression in a fruit-specific manner in non-climacteric plants. Therefore one skilled in the art was not motivated to combine the cited references in order to achieve the claimed inventive method.

The Examiner's reliance on the doctrine of inherency to bring this critical limitation into the prior art is misplaced, as that doctrine is reserved for issues of anticipation and not applicable to issues of obviousness. Obviousness requires some suggestion or motivation to make a claimed invention. That an element in a reference is not express but inherent undercuts any argument that there could be a suggestion or motivation to combine that reference with another to reach a finding of obviousness. As stated previously, one skilled in this art had no prior knowledge that fruit-specific promoters from blackcurrant could control gene expression in a fruit-specific manner in non-climacteric plants, and therefore could not have conceived of the embodiment of the instant invention set forth in Claim 18 (see In re Deuel, 51 F.3d 1552, 1558 (Fed Cir. 1995) ("What cannot be contemplated or conceived cannot be obvious.")). Inherency requires that a result must inevitably and necessarily occur (see Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264 (Fed. Cir. 1991)). The inherent property of blackcurrent as a non-climacteric fruit is acknowledged. However, one skilled in this art would fail to control gene expression in a fruit-specific manner in a climacteric plant using a blackcurrent fruit-specific promoter. That is, without the teaching and guidance of the instant invention, control of fruit-specific gene expression using promoters from blackcurrant would not necessarily and inevitably result.

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In view of the amendments and remarks set forth herein, Applicants respectfully request reconsideration of the examiner's final rejection.

Respectfully submitted,



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